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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,215	01/14/2002	Harrison McCoy	02-10450	3560

7590 06/11/2003

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,215

Applicant(s)

MCCOY, HARRISON

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

The preliminary amendment Paper No. 3 dated March 26, 2003 has been made of record.

The pending claims of record are claims 1-33.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"The consisting essentially of" phrase in line 1 of claim 22 is in conflict with the "comprises" in lines 2-3 of claim 22 and therefore is confusing and indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 9, 15-17 and 23-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Killick et al (Killick) WO 95/02654.

Killick teaches a method for producing an additive comprising an alcohol, e.g. ethanol, and bio-diesel fuel and a fuel comprising said additive and additives and fuel composition comprising said additives, note composition 1 and 2 of page 4, lines 11-18

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of page 4, compositions 4 and 7 of page 5, compositions 11 and 12 of page 6, compositions 13-17 of page 7, compositions 22 of page 8, compositions 25-27 of page 9, compositions 28-29 and 32 and compositions 33 of page 11 line 24 to page 12 line 5, additives 1-3 of page 12, additive 5 of page 13 and additives 8 and 10 of page 14 that clearly anticipates the instant claims.

Claims 1-4, 7, 15-19, 22, 26, 28-31 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gibuet et al (Gibuet) GB 2,090,611 A.

Gibuet teaches processes for producing biodiesel esters and bio-diesel esters and an alcohol and diesel fuel comprising said additives that anticipates the instant claims, note page 5, examples 2, especially the composition of gas oil I containing 88% oleate to 12% alcohol and examples 3-13. The examiner takes the position that cleanability properties are inherent in the additive and fuel composition because the bio-diesel and alcohol are the same component as those of the instant claims. It has been held that composition of the same nature inherently have the same properties.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 8-14, 20-21, 27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibuet et al (Gibuet) GB 2,090,611 A.

Gibuet teaches and discloses method for producing additives comprising up to 88% bio-diesel and the balance methanol and at least 76% of diesel fuel, example 2 of

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page 5 that suggests the 90% bio-diesel fuel and the 93-95% bio-diesel rendering claims 5-6 and 20-21 obvious.

Patentee further teaches 20 to 90% diesel fuel, 5-60% methanol and 5 to 60% bio-diesel that render obvious claims 8-14, 27 and 32. The examiner takes the position that increasing the diesel fuel up to 80% would inherently increase the cetane number up to @ 62.9, especially in view of the teachings of the examples 2 on page 5 showing that increasing the diesel fuel from 20 to 76% increase the cetane number from 39.9 to 52.8. The examiner also takes the position that the cleanability property of claim 32 is inherent inasmuch as the additive and fuel composition is the same and in their components are present in the same relative proportion as the additive and composition of the instant claims.

The prior art cited but not applied further teaches bio-diesel fuels and additives of the same nature as claimed by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh  
June 10, 2003

  
MARGARET MEDLEY  
PRIMARY EXAMINER